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Total Number of Pages in This Submission

Application Number 09/850,149

Filing Date May 8, 2001

First Named Inventor Clifton A. Rau

Art Unit 2128

Examiner Name Hugh M. Jones

Attorney Docket Number CARAU001

ENCLOSURES (Check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Potomac Patent Group, PLLC		
Signature			
Printed name	Steven M. duBois		
Date	August 25, 2006	Reg. No.	35,023

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Patent
Attorney's Docket No. CARAU001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	BOX Appeal Brief
)	
Clifton A. RAU)	Group Art Unit: 2128
)	
Application No.: 09/850,149)	Examiner: Hugh M. Jones
)	
Filed: May 8, 2001)	
)	
For: MODEL RAILROAD CONTROL)	
AND DISPLAY SYSTEM)	

REPLY BRIEF

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal filed on October 31, 2005 and Appeal Brief filed April 24, 2006 in connection with the above-identified application, submitted herewith is a reply to the Examiner's Answer dated June 28, 2006.

REMARKS

The undersigned has read the Examiner's Answer and is providing the below comments for clarification which are organized in correspondence with the relevant section of the Examiner's Answer.

(5) Summary of Claimed Subject Matter

In the Examiner's Answer, it is stated that "The original specification did include page numbers. The correct listing of page numbers does not include the cover sheet." However, the undersigned's copy of the specification does not include page numbers. Therefore, as stated in the Appeal Brief, the undersigned considered page one to be the cover page merely for reference purposes to assist the Board in finding the pages cited in the Appeal Brief.

(10) Response to Argument

It is well established that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Even with the addition of references to sections of Tanner et al. that were not relied upon in the Final Official Action, it is respectfully submitted that not all of the elements of Appellant's claims are disclosed. Brief examples with respect to each of Appellant's claim 20 elements a-c (and where relevant, independent claims 1 and 11) and the dependent claims will be described below.

Independent Claim 20

In Appellant's claim 20 element a) it is described that "wherein a first portion of said model railroad layout is displayed using a first visual characteristic and a second portion of said model railroad is displayed using a second visual characteristic, wherein said first portion is selected to allow train movement thereon, and where said second portion is deselected to prevent train movement thereon". The cited sections of Tanner used in the Examiner's Answer do not specifically show the claimed relationships between a first portion of said model railroad layout, a first visual characteristic and allowing train movement. Similar comments apply to Appellant's independent claim 1.

In Appellant's claim 20 element b) it is described that "said graphical user interface including an editing function that selectively permits a user to, rotate, move, delete and join a track portion based on a type of track portion which is selected". The Examiner's Answer states that "The Examiner would point out that any track in a model train set typically has at least two types of tracks, namely straight sections and curved sections" and a section of Tanner (col. 15, lines 12-20; Figs. 5, 11, 13). The combination of the Examiner's statement and the section of Tanner do not specifically describe an editing function that selectively permits the claimed functions based on a type of track portion which is selected.

With respect to Appellant's claim 20 element c) as described in the Appeal Brief and the Examiner's Answer:

"while the cited sections of Tanner ... do describe using an 8-bit solenoid address and a 4 bit addressing scheme, this is not identical to Appellant's claim element c) wherein the command includes three address bits, four group bits and one data bit."

The Examiner admits that this element is missing from Tanner -- "the Examiner agrees that they are 'different', but fails to see the patentable distinction". Since they are admittedly "different", Tanner also does not anticipate Appellant's claim c) element. Similar comments apply to Appellant's independent claim 11.

The Examiner's Answer continues to muse on this point that having a command with three address bits, four group bits and one data bit is a "subset" of Tanner's disclosed use of an 8-bit solenoid address and a 4 bit addressing scheme. Appellants also disagree with this characterization. The claimed combination reflects an intended data architecture that is unique to the claimed combination. For example, Tanner does not teach or suggest a signaling architecture which in any way contemplates designating addressable "groups" as does the claimed combination.

Regarding Dependent Claims "Appellant Merely Recites the Claim Limitations"

On page 11, in the last full paragraph prior to the heading entitled "(11) Related Proceeding(s) Appendix", the Examiner's Answer provides its only response to the arguments previously submitted in Appellant's Brief on page 9 under the heading "Dependent Claims 14, 15, 18 and 19". Initially, the undersigned notes that the Examiner does not contest the omission by Tanner of the specific claim elements identified in the Brief.

In order to successfully rebut an allegation of anticipation, it is, in fact, only necessary to point out those elements which are not expressly or inherently

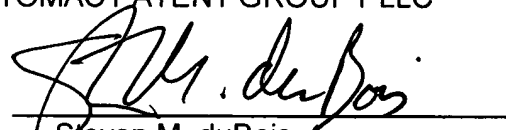
disclosed by the cited reference. Appellant has done so and need do no more. Although the Examiner apparently would prefer to shift the burden to Appellant to explain "why the use" of one claimed element is "thought to be patentable", that is not the standard of patentability for anticipation.

Claims 1-11, 13-15 and 18-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tanner et al. For at least the foregoing reasons and the reasons cited in the Corrected Appeal Brief dated April 24, 2006, it is respectfully submitted that the claims are patentable over the document cited. Accordingly, it is respectfully requested that the Final Rejection in the Official Action of July 26, 2005 be REVERSED.

Respectfully submitted,

POTOMAC PATENT GROUP PLLC

By:


Steven M. duBois
Registration No. 35,023

Date: August 25, 2006